



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,558	05/24/2001	Henry H. Yamamoto	20643/0203982-US0 Diego	4801
60539	7590	07/24/2007	7	
Digeo c/o DARBY & DARBY P.C. P.O. BOX 770 Church Street Station NEW YORK, NY 10008-0770			EXAMINER HOYE, MICHAEL W	
			ART UNIT 2623	PAPER NUMBER
			MAIL DATE 07/24/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/866,558	Applicant(s) YAMAMOTO, HENRY H.	
	Examiner Michael W. Hoyer	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,8-13,15-20,22-27,29,30 and 37-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,8-13,15-20,22-27,29,30 and 37-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on May 7, 2007 have been fully considered but they are not persuasive.

Regarding independent claims 1, 17, 26, 37 and 41, the Applicant argues on page 9 that, "Newly cited Williams does not teach or disclose *"filtering the information to exclude coupons from merchants not listed on a participating merchant list"*, as recited for example in Claim 1, and similar features recited in the remaining independent claims."

More specifically, on page 10 the Applicant argues that:

The Examiner incorrectly states that Williams' screening of coupons based on user preference and profile information discloses filtering coupons to exclude those not from merchants listed on the claimed "participating merchant list". The Examiner's argument is incorrect because user preferences regarding activities, TV programs, and types of food are not the same as a "white" list of merchants, for example a list of participating merchants whose coupons are not excluded, while coupons from merchants not on the list are filtered and excluded as variously encompassed by the independent claims. Williams' user preferences are directed to specific products or classes of products, rather than merchants. Accordingly, Williams' fails to disclose or suggest, *"filtering the information to exclude coupons from merchants not listed on a participating merchant list"*, as recited for example in Claim 1, and similar features recited in the remaining independent claims.

In response, the Examiner respectfully disagrees with the Applicant because, although the Williams reference does not specifically use the term "merchant", Williams does teach that the list of preferences that may be used as described in col. 6, lines 13-22, is not an exclusive list or an exhaustive list and many more types and combinations of preferences could be used to build

Art Unit: 2623

preference profiles (see col. 6, lines 5-6 and 12-24). More specifically, Williams discloses that, “Building of preference profiles for users allows server 320 to deliver coupons to specific users that have an observed or disclosed preference for a particular service, product or activity” (col. 6, lines 25-28), and “Coupons may also be delivered to users whose preferences include services, products or activities that are related to the service, product or activity that is the subject of a particular coupon, etc” (col. 6, lines 28-31). Furthermore, Williams teaches that, “different servers may provide coupons for different preference profiles or coupon suppliers...companies or groups who wish to have coupons delivered discloses the specifics of the coupon, such as the target audience preference profile... [And the] coupon repository then delivers the coupons to the network clients that meet the desired preference profile” (see col. 6, lines 34-48). As previously stated in the last Office Action, “Williams teaches a method and apparatus for providing and monitoring coupons via a network, wherein when one or more coupons are broadcast, the client(s) coupled to network 300 filter the coupon(s) based on preference profiles compiled by and stored in the client...[and] coupon(s) that satisfy the preference profile are passed to the client device and may be redeemed by the user (see col. 6, lines 49-56).” Although Williams does not specifically use the term “merchant”, as stated above, the claims are not limited exclusively to “only filtering the information to exclude coupons from merchants not listed on a participating merchant list”, and as stated above, Williams teaches that many types of preferences could be used to develop preference profiles including companies or groups offering specific types of coupons. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combination of references used in the rejection of the independent claims with the teachings of Williams as described above for the

Art Unit: 2623

advantage of providing filtering of coupons based on preference profiles, such as a participating merchant list.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 17-20, 23-27, 29, 30 and 37-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al (US 5,978,013), in view of Harada et al (US 20002/0120927), in further view of Williams et al (US 6,075,971).

Regarding claims 17 and 26, Jones discloses an apparatus, article of manufacture and method for generating product coupons in response to televised offers. Jones discloses advertising programming may offer a coupon for the product advertised (see col. 4, lines 60-65) by embedding a coupon identifier in a television video signal (see col. 4, lines 60-65). Jones still further discloses that transmitted advertising program may be broadcast by standard television (see col. 12, lines 54-57), which inherently includes a 'first channel of an interactive video casting system'. It is noted that the user can input a request on a remote control for the coupon (see col. 12, lines 25-47) providing for an interactive system.

Jones further discloses transmitting a coupon or token identifier in the blanked line and hence the same channel as the product advertisement (see col. 21, lines 63-67) to retrieve coupon information on a second distinct data channel (see col. 3, lines 1-9). It is noted that the token

Art Unit: 2623

identifier comprises a code which links or correlates the token identifier of the advertisement displayed on the first channel to a coupon received on the second data channel (see col. 2, line 63 – col. 3, line 9; col. 5, lines 8-29 and col. 9, lines 30-48). It is noted that Jones discloses, “This token information is either transmitted to the viewer’s site or pre-stored in a memory at the user’s site” (see col. 3, lines 1-8).

Jones discloses a user can request or ‘command’ retrieval of the coupon, based on the coupon or token identification code, by inputting a command on a remote control (see col. 9, lines 21-29), which provides retrieval of the coupon on the second or data channel to allow printing or utilization of the coupon thus enabling a user to initiate a transaction related to the coupon on the second channel (see col. 10, lines 16-30).

It is further noted, with regards to claim 26, since the coupon or token identifier is linked or correlated with at the appropriate coupon, the coupon or token identifier on the first channel is consistent with the coupon on the second channel.

Jones further discloses, in regards to the demographic information, “*The information may include whether the site is a home or business, the number of persons at the site, their ages and sexes, their consumption habits and the classes of products in which they would likely be interested*” (see col. 9, lines 10-15). Thus Jones discloses the claimed “...the information related to the coupon on the second channel including information related to the user.”

Jones fails to disclose displaying the coupon to the user on the second channel and participating in a transaction related to the coupon displayed on the second channel.

In analogous art, Harada discloses a broadcasting system which provides a user with coupons on a separate channel see ¶ [0063 - 0064] and teaches “...and the coupon information is

Art Unit: 2623

displayed as a coupon visible to the user on the EPG screen 16...” (see ¶ [0086]) and thus it is noted that Harada teaches displaying coupon information received on a second channel. Harada further teaches, “If the user decides that the coupon is unnecessary when watching the message of the DM, the coupon is cancelled, and is thus not settled (see ¶ [0096]). Harada still further teaches an object of the present invention is to “...increase the degree of freedom of issuing a coupon...” (see ¶ [0008]) and to “increase a frequency of use of coupons given to a program or the user” (see ¶ [0009]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Jones to include the claimed limitations for the benefit of giving the user the option of deciding if printing the coupon is necessary or not while increasing the degree of freedom of issuing a coupon and increasing the frequency of use of coupons.

Jones and Harada fail to disclose the claimed “instructions to filter coupons available on a second channel to exclude coupons from merchants not listed on a participating merchant list” or the claimed “displaying the coupon...if b) the coupon is offered by a merchant listed on a participating merchant list”. However, Williams teaches a method and apparatus for providing and monitoring coupons via a network, wherein when one or more coupons are broadcast, the client(s) coupled to network 300 filter the coupon(s) based on preference profiles compiled by and stored in the client...coupon(s) that satisfy the preference profile are passed to the client device and may be redeemed by the user (see col. 6, lines 49-56). Although the Williams reference does not specifically use the term “merchant”, Williams does teach that the list of preferences that may be used as described in col. 6, lines 13-22, is not an exclusive list or an exhaustive list and many more types and combinations of preferences could be used to build

Art Unit: 2623

preference profiles (see col. 6, lines 5-6 and 12-24). More specifically, Williams discloses that, “Building of preference profiles for users allows server 320 to deliver coupons to specific users that have an observed or disclosed preference for a particular service, product or activity” (col. 6, lines 25-28), and “Coupons may also be delivered to users whose preferences include services, products or activities that are related to the service, product or activity that is the subject of a particular coupon, etc” (col. 6, lines 28-31). Furthermore, Williams teaches that, “different servers may provide coupons for different preference profiles or coupon suppliers... companies or groups who wish to have coupons delivered discloses the specifics of the coupon, such as the target audience preference profile... [And the] coupon repository then delivers the coupons to the network clients that meet the desired preference profile” (see col. 6, lines 34-48). Although Williams does not specifically use the term “merchant”, as stated above, the claims are not limited exclusively to “only filtering the information to exclude coupons from merchants not listed on a participating merchant list”, and as stated above, Williams teaches that many types of preferences could be used to develop preference profiles including companies or groups offering specific types of coupons. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combination of Jones and Harada with the teachings of Williams as described above for the advantage of providing filtering of coupons based on preference profiles, such as a participating merchant list.

Regarding claims 18-19, Jones discloses correlating by automatically entering and comparing demographic information which is related to the user which identifies the user terminal (see col. 9, lines 4-13).

Art Unit: 2623

Regarding claim 20, Jones discloses integrating coupon ID information relating to coupons and coupon channel in the television commercial channel sent from the interactive video casting system to the client terminal (see col. 4, line 60 - col. 5, line 27).

Regarding claim 23, Jones discloses transmitting coupons onto a smart card (see col. 2, lines 59-62) as the claimed 'instructions' are inherent as necessary to perform the claimed functions.

Regarding claim 24, Jones discloses integrating coupon ID information relating to coupons and coupon channel in the television commercial channel sent from the interactive video casting system to the client terminal (see col. 4, line 60 - col. 5, line 27) as the claimed 'instructions' are necessary to perform the claimed functions.

Regarding claim 25, the combination of Jones and Harada fails to disclose the claimed wherein the machine-readable medium further includes instructions stored thereon to allow the user to send a coupon to an email address.

Official Notice is taken it is well known for a user to send information to an email address to enable forwarding of information to a destination of user's choice. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combination of Jones and Harada to include the claimed limitation to enable a user to send the coupon to a choice destination.

Regarding claim 27, Jones discloses the claimed coupon includes merchant information (see col. 11, lines 58-63).

Art Unit: 2623

Regarding claim 29, it is noted that since the coupon is sent to the requesting user, Jones inherently discloses the claimed “wherein the information related to the user is obtained by obtaining a set top box identifier.”

Regarding claim 30, Jones discloses a printing device for printing and redeeming the coupon (see col. 10, lines 16-30).

Regarding claims 37 and 41, Jones discloses an apparatus, article of manufacture and method for generating product coupons in response to televised offers. Jones discloses advertising programming may offer a coupon for the product advertised (see col. 4, lines 60-65) by embedding a coupon identifier in a television video signal (see col. 4, lines 60-65). Jones still further discloses that transmitted advertising program may be broadcast by standard television (see col. 12, lines 54-57), which inherently includes a ‘first channel’ of an interactive video casting system. It is noted that the user can input a request on a remote control for the coupon (see col. 12, lines 25-47) providing for an interactive system. Jones further discloses that the commercial can be stored and retrieved from one or more optical disk sources to provide coupons for the coupon channel (see col. 6, lines 43-63). It is noted that more than one optical disks constitute a plurality of sources. Jones further discloses the coupon is affiliated with one advertiser or merchant which is in communication with the interactive video casting system (see col. 11, lines 58-65). Jones discloses the offering the coupon includes providing a plurality of features related to transactions that can be conducted with any of the coupons available from the coupon channel including storage of the coupon printing of the coupon, a discount amount utilized in coupon transactions and a UPC bar-code utilized in coupon transactions.

Art Unit: 2623

Jones discloses a user can request or 'command' retrieval of the coupon, based on the coupon or token identification code, by inputting a command on a remote control (see col. 9, lines 21-29), which provides retrieval of the coupon on the second or data channel to allow printing or utilization of the coupon thus enabling a user to initiate a transaction related to the coupon on the second channel (see col. 10, lines 16-30). It is noted that the transaction of printing is subsequent to the correlation of the received command with offered coupon.

Jones fails to disclose providing an electronic notification related to the offered coupon form the interactive video casting system subsequent to conducting the transaction, the electronic notification capable of being provided to the client terminal for display on the display screen.

Official Notice is taken it would have been notoriously well known to provide an electronic notification after a transaction of transferring data to notify and to ensure a receiver is aware that data has been transmitted. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Jones to include providing a electronic notification related to the offered coupon subsequent to the conducting the transaction to ensure the receiver is notified that the coupon has been sent and should have been received.

As discussed above, Jones discloses providing a coupon via a separate data channel, but fails to disclose the claimed electronic notification further capable of being provided on one of the channels of the interactive video casting system that is different form the coupon channel.

Based on the suggestion of Jones to transmit coupons on a separate data channel, it would have been obvious to further modify Jones to transmit the electronic notification discussed above

Art Unit: 2623

on the separate data channel to maximize bandwidth and system efficiency by placing all the supplemental data on one channel. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Jones to include the claimed limitation to maximize bandwidth and system efficiency.

Jones fails to disclose a coupon channel comprising “one of a plurality of different user-viewable channels” and “presentation on the another of the plurality of different channels” and “displaying the offered coupon on the coupon channel via the display screen”.

In analogous art, Harada discloses a broadcasting system which provides a user with coupons on a separate channel see ¶ [0063 - 0064] and teaches “...*and the coupon information is displayed as a coupon visible to the user on the EPG screen 16...*” (see ¶ [0086]) and thus it is noted that Harada teaches displaying coupon information received on a second channel. Harada further teaches “If the user decides that the coupon is unnecessary when watching the message of the DM, the coupon is cancelled, and is thus not settled” (see ¶ [0096]). Harada still further teaches an object of the present invention is to “...increase the degree of freedom of issuing a coupon...” (see ¶ [0008]) and to “increase a frequency of use of coupons given to a program or the user” (see ¶ [0009]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Jones to include the claimed limitations for the benefit of giving the user the option of deciding if printing the coupon is necessary or not while increasing the degree of freedom of issuing a coupon and increasing the frequency of use of coupons.

Jones and Harada fail to disclose the claimed “offering the coupon comprises excluding coupons from merchants not listed on a participating merchant list” and “the offered coupon

Art Unit: 2623

being... listed on the participating merchant list”, or the claimed “wherein offering the coupon comprises filtering the triggers to prevent offering of coupons from merchants not listed on a participating merchant list”. However, Williams teaches a method and apparatus for providing and monitoring coupons via a network, wherein when one or more coupons are broadcast, the client(s) coupled to network 300 filter the coupon(s) based on preference profiles compiled by and stored in the client...coupon(s) that satisfy the preference profile are passed to the client device and may be redeemed by the user (see col. 6, lines 49-56). Although the Williams reference does not specifically use the term “merchant”, Williams does teach that the list of preferences that may be used as described in col. 6, lines 13-22, is not an exclusive list or an exhaustive list and many more types and combinations of preferences could be used to build preference profiles (see col. 6, lines 5-6 and 12-24). More specifically, Williams discloses that, “Building of preference profiles for users allows server 320 to deliver coupons to specific users that have an observed or disclosed preference for a particular service, product or activity” (col. 6, lines 25-28), and “Coupons may also be delivered to users whose preferences include services, products or activities that are related to the service, product or activity that is the subject of a particular coupon, etc” (col. 6, lines 28-31). Furthermore, Williams teaches that, “different servers may provide coupons for different preference profiles or coupon suppliers...companies or groups who wish to have coupons delivered discloses the specifics of the coupon, such as the target audience preference profile... [And the] coupon repository then delivers the coupons to the network clients that meet the desired preference profile” (see col. 6, lines 34-48). Although Williams does not specifically use the term “merchant”, as stated above, the claims are not limited exclusively to “only filtering the information to exclude coupons from merchants not

Art Unit: 2623

listed on a participating merchant list", and as stated above, Williams teaches that many types of preferences could be used to develop preference profiles including companies or groups offering specific types of coupons. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combination of Jones and Harada with the teachings of Williams as described above for the advantage of providing filtering of coupons based on preference profiles, such as a participating merchant list.

Claim 38 is met by the above discussions.

Regarding claims 39 and 42, Jones discloses wherein offering the coupon comprises offering the coupon during a television program that is presented on a channel different from the coupon channel (see col. 2, line 63 - col. 3, line 8).

Regarding claims 40 and 43, Jones fails to disclose the claimed wherein notification is capable of being provided to a device different from the client terminal.

Jones suggests the user of sending information to a smart card (as discussed above). Official notice is taken that it would have been well known to send notification information to another portable device like a remote control, PDA, or pager etc. Therefore, it would have been obvious to modify Jones to include the claimed limitations for the benefit of providing a notification to a portable handheld device which is easily accessible by a user.

Regarding claim 44, Jones discloses printing the coupons (see col. 10, lines 16-30).

4. Claims 1, 2, 4, 5, 9, 11, 13 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (US 5,978,013), in view of Harada et al (US 2002/0120927), in further

Art Unit: 2623

view of Williams et al (US 6,075,971), in further view of Lemon et al (US 4,674,041), and in further view of Platt (US 2002/0138349).

Regarding claim 1, Jones discloses an apparatus, article of manufacture and method for generating product coupons in response to televised offers. Jones discloses advertising programming may offer a coupon for the product advertised (see col. 4, lines 60-65) by embedding a coupon identifier in a television video signal (see col. 4, lines 60-65). Jones still further discloses that transmitted advertising program may be broadcast by standard television (see col. 12, lines 54-57), which inherently includes a 'first channel of an interactive video casting system'. It is noted that the user can input a request on a remote control for the coupon (see col. 12, lines 25-47) providing for an interactive system.

Jones further discloses transmitting a coupon or token identifier in the blanked line and hence the same channel as the product advertisement (see col. 2, lines 63-67) to retrieve coupon information on a second distinct data channel (see col. 3, lines 1-9). It is noted that the token identifier comprises a code which links or correlates the token identifier of the advertisement displayed on the first channel to a coupon received on the second data channel (see col. 2, line 63 - col. 3, line 9; col. 5, lines 8-29; and col. 9, lines 30-48). It is noted that Jones discloses "This token information is either transmitted to the viewer's site or pre-stored in a memory at the user's site" (see col. 3, lines 1-8).

Jones discloses a user can request or 'command' retrieval of the coupon, based on the coupon or token identification code, by inputting a command on a remote control (see col. 9, lines 21-29), which provides retrieval of the coupon on the second or data channel to allow

Art Unit: 2623

printing or utilization of the coupon thus enabling a user to initiate a transaction related to the coupon on the second channel (see col. 10, lines 16-30).

Jones fails to disclose “wherein the second channel is viewable and navigable by the user.”

In analogous art, Harada discloses a broadcasting system which provides a user with coupons on a separate channel see ¶ [0063 - 0064] and teaches “...*and the coupon information is displayed as a coupon visible to the user on the EPG screen 16...*” (see ¶ [0086]) and thus it is noted that Harada teaches displaying coupon information received on a second channel. Harada further teaches “If the user decides that the coupon is unnecessary when watching the message of the DM, the coupon is cancelled, and is thus not settled” (see ¶ [0096]). Harada still further teaches an object of the present invention is to “...*increase the degree of freedom of issuing a coupon...*” (see ¶ [0008]) and to “*increase a frequency of use of coupons given to a program or the user*” (see ¶ [0009]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Jones to include the claimed limitations for the benefit of giving the user the option of deciding if printing the coupon is necessary or not while increasing the degree of freedom of issuing a coupon and increasing the frequency of use of coupons.

Jones and Harada fail to disclose the claimed “filtering the information to exclude coupons from merchants not listed on a participating merchant list”. However, Williams teaches a method and apparatus for providing and monitoring coupons via a network, wherein when one or more coupons are broadcast, the client(s) coupled to network 300 filter the coupon(s) based on preference profiles compiled by and stored in the client...coupon(s) that satisfy the preference

Art Unit: 2623

profile are passed to the client device and may be redeemed by the user (see col. 6, lines 49-56). Although the Williams reference does not specifically use the term “merchant”, Williams does teach that the list of preferences that may be used as described in col. 6, lines 13-22, is not an exclusive list or an exhaustive list and many more types and combinations of preferences could be used to build preference profiles (see col. 6, lines 5-6 and 12-24). More specifically, Williams discloses that, “Building of preference profiles for users allows server 320 to deliver coupons to specific users that have an observed or disclosed preference for a particular service, product or activity” (col. 6, lines 25-28), and “Coupons may also be delivered to users whose preferences include services, products or activities that are related to the service, product or activity that is the subject of a particular coupon, etc” (col. 6, lines 28-31). Furthermore, Williams teaches that, “different servers may provide coupons for different preference profiles or coupon suppliers...companies or groups who wish to have coupons delivered discloses the specifics of the coupon, such as the target audience preference profile... [And the] coupon repository then delivers the coupons to the network clients that meet the desired preference profile” (see col. 6, lines 34-48). Although Williams does not specifically use the term “merchant”, as stated above, the claims are not limited exclusively to “only filtering the information to exclude coupons from merchants not listed on a participating merchant list”, and as stated above, Williams teaches that many types of preferences could be used to develop preference profiles including companies or groups offering specific types of coupons. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combination of Jones and Harada with the teachings of Williams as described above for the advantage of providing filtering of coupons based on preference profiles, such as a participating merchant list.

Art Unit: 2623

Jones fails to disclose the claimed “providing a notification to a user of an expiration date of a coupon separate from the expiration date printed on the coupon.”

In analogous art, Lemon teaches a method and apparatus for controlling the distribution of coupons and further teaches, “...*said host central processing unit further including means for periodically transmitting to each terminal coupon limits such as and including expiration date...*” (see col. 33, lines 34 - 37). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Jones to include providing a notification to a user of an expiration date of a coupon separate from the expiration date printed on the coupon for the benefit of periodically alerting a user to the expiration date of the coupon to ensure the user uses the coupon before it expires.

Jones fails to disclose the claimed “automatically generating a reminder of an upcoming coupon expiration date.”

In analogous art, Platt teaches a method and apparatus for controlling the distribution of coupons and further teaches, “...*In these offers the existence and presence of the original UNOC [Uniquely Numbered Offer Code] number is highlighted and can be promoted as an “electronic coupon”, constantly reminding the interested prospect of the present terms and sense of urgency (expiration date) of that offer.*” (see ¶ [0118]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Jones to include automatically generating a reminder of an upcoming coupon expiration date for the benefit of alerting or notifying a user to the expiration date of the coupon to ensure the user uses the coupon before it expires without requiring a user to manually enter a reminder.

Regarding claim 2, the combination of Jones and Harada discloses the claimed limitation, wherein Jones discloses the interactive system is a television system (see col. 4, lines 33-39) and Harada discloses the claimed wherein the information included with the television program on the first channel includes triggers that announce availability of the coupon on the second channel (see ¶ [0070]).

Regarding claim 4, the combination of Jones, Harada, Williams and Lemon fails to disclose the claimed wherein linking the first channel to the second channel over at least a portion of the television program, generating a picture-in-picture arrangement to concurrently present the content on the second channel with the television program on the first channel, or tuning from the first channel to the second channel to replace presentation of the television program with presentation of the content.

Official notice is taken it would have well known to overlay supplemental content on program content to enable a user to view both content simultaneously. Therefore, it would have been obvious to one having ordinary skill in the art, at the time the invention was made to modify the combination of Jones, Harada, Williams and Lemon to include the claimed limitation to enable a user to simultaneously view the commercial advertisement with the coupon.

Regarding claim 5, the combination of Jones and Harada discloses the claimed limitation, wherein Jones discloses demographic information or user-related data which includes ages, consumption habits etc. which is utilized with respect to linking and retrieving coupons (see col. 9, lines 4-19) and wherein Harada discloses the claimed wherein the user-related data can be automatically obtained by receiving an identifier of a client terminal of the user (see ¶ [0064] and ¶ [0068]).

Art Unit: 2623

Regarding claim 9, Jones discloses providing coupons on a separate different channel and thus suggests that transmitting of information need not be limited to one channel. It would have been obvious to modify the combination of Jones, Harada, Williams and Lemon to include sending the coupon notification on a coupon on a channel different from the second channel. Therefore, it would have been obvious to modify Jones to include the claimed limitation for the benefit of providing a user with coupon expiration information on a data channel which is separate from the program channel and thus maximizing bandwidth efficiency by balancing the transmission of data on a variety of channels.

Regarding claim 11, Jones discloses an image memory for storing the coupon before printing (see col. 10, lines 16-30).

Regarding claim 13, Jones discloses a printing device for printing and redeeming the coupon (see col. 10, lines 16-30). Jones further discloses generating a token or "coupon" (see col. 1, lines 12-16) and the generator may produce tokens or coupons in the form of a smart card (see col. 2, lines 58-63). Necessarily, Jones discloses transferring information related to the coupon to a smart card.

Claim 22 is met by the rejection of claim 1 as described above.

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (US 5,978,013), in view of Harada et al (US 2002/0120927), in view of Williams et al (US 6075,971), in view of Lemon et al (US 4,674,041), in view of Platt (US 2002/0138349), and in further view of Wehmeyer (US 6,169,543).

Art Unit: 2623

Regarding claim 8, the combination of Jones, Harada, Williams, Lemon and Platt fails to disclose the claimed obtaining from the user a preference for a date to be notified of the expiration data of the coupon.

In analogous art, Wehmeyer teaches a system and method wherein a user can input preference information as to what date and time to be automatically notified and reminded about important information (see Fig. 5A). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Jones, Harada, Williams, Lemon and Platt to include the claimed limitation for the benefit of being notified as to the expiration date of the coupon at a time preference of the user, to ensure that the user uses the coupon before it expires.

6. Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (US 5,978,013), in view of Harada et al (US 2002/0120927), Williams et al (US 6,075,971), in view of Lemon et al (US 4,674,041), in view of Platt (US 2002/0138349), as applied to the claims above, and further in view of Walkingshaw et al (US 5,488,423).

Regarding claim 10, Jones discloses retrieving and printing the appropriate coupon based on a code and thus discloses the claimed "wherein the transaction related to the coupon includes searching for one or more coupons" (see col. 9, lines 30-67 and col. 10, lines 16-30). The combination of Jones, Harada, Williams and Lemon fails to disclose searching based on one or more of a user-selected merchant category, a user-selected service category, or a user-provided keyword.

Art Unit: 2623

In analogous art, Walkingshaw teaches a home communication system for receiving coupons and teaches “...*the consumer receives coupons or other printed matter only for categories of products or types of information pre-selected by the consumer*” (see col. 2, lines 28-31). Therefore, it would have been obvious to modify the combination of Jones, Harada, Williams and Lemon to include the claimed limitation for the benefit of providing a user with coupons which are most desired and useful to a user.

Regarding claim 12, Jones discloses sorting the plurality of coupons in an order for a viewer to select (see col. 10, lines 50-67).

In analogous art, Walkingshaw teaches method and apparatus for sorting coupons according to categories selected by a user (see col. 2, lines 50-56). Walkingshaw is evidence that sorting coupons according to a category would have been well known. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Jones to include the claimed limitation for the benefit of providing coupons preferable to a user.

7. Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (US 5,978,013), in view of Harada et al (US 2002/0120927), Williams et al (US 6,075,971), in view of Lemon et al (US 4,674,041), in view of Platt (US 2002/0138349), as applied to the claims above, and further in view of Fortenberry et al (US 6,336,098).

Regarding claims 15 and 16, the combination of Jones, Harada, Williams and Lemon fails to disclose wherein the transaction related to the coupon includes redeeming the coupon and wherein redeeming the coupon includes redeeming the coupon on a merchant web site.

Art Unit: 2623

Official Notice is taken it would have been notoriously well known in the art the use of PCTV or web TV with a virtual channel would provide a viewer with a access to wide variety of programming and resources which would include e-shopping or shopping on the Internet. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the existing TV in Jones to a PCTV or web TV with a virtual channel to provide a user with access to a wide variety of resources thereby enhancing a user's viewing experience.

In analogous art, Fortenberry et al teaches a method for electronic distribution and redemption of coupons on the world wide web (see Abstract). Fortenberry further teaches "*With the growth of the Internet, e-commerce and secure transactions, more consumers are purchasing items over the Internet*" (see col. 1, lines 51-55). It would have been obvious to modify Jones to include allowing a user to redeem the coupon on a virtual channel (a separate channel) coupled to the Internet and merchant web site for the benefit of providing a user with discounts which are redeemable over a widely accessible network offering secure transactions. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Jones to include the claimed "redeeming the coupon and wherein redeeming the coupon includes redeeming the coupon on a merchant web site" for the benefit of enabling a user to redeem coupons from home over a secure, widely accessible network.

Art Unit: 2623

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael W. Hoyer whose telephone number is **571-272-7346**. The examiner can normally be reached on Monday to Friday from 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller, can be reached at **571-272-7353**.

Any response to this action should be mailed to:

Please address mail to be delivered by the United States Postal Service (USPS) as follows:

Mail Stop _____
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Art Unit: 2623

Except correspondence for Maintenance Fee payments, Deposit Account Replenishments (see 1.25(c)(4)), and Licensing and Review (see 37 CFR 5.1(c) and 5.2(c)), please address correspondence to be delivered by other delivery services (Federal Express (Fed Ex), UPS, DHL, Laser, Action, Purolater, etc.) as follows:

United States Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Some correspondence may be submitted electronically. See the Office's Internet Web site <http://www.uspto.gov> for additional information.

Or faxed to: 571-273-8300

Hand-delivered responses should be brought to the Customer Service Window at the address listed above.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is **571-272-2600**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197** (toll-free).

Michael W. Hoye
July 14, 2007


ANDREW Y. KOENIG
PRIMARY PATENT EXAMINER